



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV

Paper No.

ELAN DRUG DELIVERY, INC.  
C/O FOLEY & LARDNER LLP  
3000 K STREET, N.W.  
SUITE 500  
WASHINGTON DC 20007-5109

**MAILED**

**MAR 29 2010**

**OFFICE OF PETITIONS**

In re Application of	:	
Rajeev A. Jain, Jon Swanson,	:	
Robert Hontz, John Devane,	:	
Jenneth Iain Cumming, Maurice	:	
Joseph Anthony Clancy, and	:	
Janet Elizabeth Codd	:	DECISION ON TWO SECOND
Application No. 09/337,675	:	RENEWED PETITIONS PURSUANT
Filing Date: June 22, 1999	:	TO 37 C.F.R. §§ 1.48 AND
Attorney Docket Number:	:	1.183
029318/0497	:	
Title: CONTROLLED-RELEASE	:	
NANOPARTICULATE COMPOSITIONS	:	

This is a decision on the two second renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on March 11, 2010. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

The renewed petition pursuant to 37 C.F.R. § 1.48(a)(3) is **GRANTED**.

The renewed petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED AS MOOT**.

Two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on July 3, 2008. The former was supplemented via a submission on July 17, 2008. Petitioner provided, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R.

§ 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

Both petitions were dismissed via the mailing of a single decision on March 30, 2009.

Two renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on April 15, 2009. Each was dismissed via the mailing of a single decision on February 16, 2010.

With these second renewed petitions, Petitioner has submitted a declaration that has been executed by formerly non-signing joint inventor Cumming.

A corrected filing receipt has been included with this decision.

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the present application can receive further processing in due course.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.<sup>1</sup> All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanowski/  
Paul Shanowski  
Senior Attorney  
Office of Petitions

Encl. corrected filing receipt

---

<sup>1</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
09/337,675	06/22/1999	1615	2006	029318/0497	35	3

CONFIRMATION NO. 9275

## CORRECTED FILING RECEIPT



0000000040825002

31049

Elan Drug Delivery, Inc. c/o Foley & Lardner  
3000 K Street, N.W.  
Suite 500  
Washington, DC 20007-5109

Date Mailed: 03/29/2010

Receipt is acknowledged of a CPA in this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

## Applicant(s)

RAJEEV A. JAIN, NORRISTOWN, PA;  
JON SWANSON, NORTH WALES, PA;  
ROBERT HONTZ, NEWTOWN SQUARE, PA;  
JOHN DEVANE, ATHLONE, IRELAND;  
KENNETH IAIN CUMMING, DUBLIN, IRELAND;  
MAURICE JOSEPH ANTHONY CLANCY, CO Kildare, IRELAND;  
JANET ELIZABETH CODD, Westford, IRELAND;  
gary Liversidge, Westchester, PA;

## Power of Attorney:

Arthur Schwartz--22115  
Sybil Meloy--22749  
Richard Linn--25144  
Harold Wegner--25258  
Richard Schwaab--25479

Kenneth Krosin--25735  
Peter Mack--26001  
David Blumenthal--26257  
William Ellis--26874  
Charles Schill--27590

## Domestic Priority data as claimed by applicant

## Foreign Applications

If Required, Foreign Filing License Granted: 07/20/1999

The country code and number of your priority application, to be used for filing abroad under the Paris Convention,  
is **US 09/337,675**

CPA Filed on: 02/28/2001

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No  
**Title**

CONTROLLED-RELEASE NANOPARTICULATE COMPOSITIONS

**Preliminary Class**

424

## **PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**  
**Title 35, United States Code, Section 184**  
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).